Supreme Court, U. S.
FILED
JUN 21 1977
MICHAEL RODAK, JR., CLERK

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1976

No. 76-1413

HENRY B. BRAINERD, PETITIONER

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

REPLY BRIEF FOR PETITIONER

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Petitioner replies to Respondent's Brief as follows:

The Memorandum of Respondent is seriously in error in three ways.

First, it is clear that the prior art cited by the Patent Office

(Orthuber and Kolanowski) was not as respondent suggests, sufficiently close to applicant's claim to warrant rejection under 35 USC Sec. 103, on those two references alone. Not only the Board of Appeals but also the Court of Customs and Patent Appeals recognized that an additional citation of prior art was required. The Board held that the missing prior art could be supplied by referring to what it considered "common knowledge". This holding of the Board, however, was in error because a "common knowledge" rejection, if traversed, (and this one had been traversed) must be supported by the citation of a specific

reference, or else withdrawn. The CCPA apparently recognized the Board's error and instead of relying upon the "common knowledge" rejection of the Board, the CCPA held that the ordinary artisan is "chargeable" with knowledge of the substance of the missing prior art reference. We do not think that this cured the defect, nor did Judge Baldwin who dissented.

Second, the Respondent's reference to the depositions of two witnesses without explaining the full facts is particularly unfair. The witness, Mr. Redman, testified in 1970 (many years too late), that he thought the choice was obvious, but in 1956 when he actually had the material in his hand and had the choice to make, at a time when it

was relevant , he rejected it. He only came back to it many years later after petitioner's invention had been proven. We think this is good evidence of non-obviousness at the earlier date. The other witness Mr. Wilcox was a salesman of Scotchlite. He was promoting Scotch-lite as a product for any conceivable use. To him any remote possibility of using it would not only have been obvious but also desireable. However, when he was asked what reaction he encountered in the field from those actually skilled in the relevant art, he said that the ordinary person in that art, was not aware of the characteristics of Scotch-lite "that would be significant here". Therefore, the testimony of neither of these two gentlemen, actually stands for

the proposition which the Respondent urges, but, instead, supports petitioner.

Finally, the decision in the Massachusetts case cited in footnote No. 1 at page 3 of Respondent's Memorandum is referred to in a misleading way. In the petition here at bar, the claim of the patent in issue is directed to the marker which is affixed to the sides of the railroad cars. The claim in issue in the Massachusetts case was for a combined system. The Sylvania combined system was held not to infringe the system claim there in issue, but the decision of the Court had nothing to do with the marker per se. The claims here in issue read point for point directly on the Sylvania marker. The Respondent is aware of this and to refer to the Massachusetts decision in such a way as

to leave an impression that the holding therein of non-infringement somehow applied to the case at bar, is, in our submission, deceptive and unfair.

Respectfully submitted,

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